

REMARKS

Pursuant to the Notice of Non-Compliant Amendment dated December 12, 2007, Applicants have elected to pursue claims under Species I and have canceled claims 153-176, which are asserted by the Examiner as belonging to Species II. Since claims 83-114 were objected to and rejected in the Office Action dated October 30, 2006, reconsideration of the objection and the rejections set forth in that Office Action is respectfully requested. In the Office Action, the Examiner objected to claim 113 and rejected claims 83-114. Applicants previously canceled claims 83-114 without prejudice and have added herein new claims 177-201. Accordingly, claims 177-201 are pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. The Claim Amendments Are Not Made for Substantial Reasons Related to Patentability

In the Office Action, the Examiner objected to claim 113, noting a minor typographical error. Applicants appreciate the Examiner's careful examination of the present application and has made appropriate amendments to new claim 200. This claim amendment was made merely to correct the typographical error only. Therefore, the claim amendment has not been made for substantial reasons related to patentability.

B. The Pending Claims Are Fully Supported by the Original Specification.

In the Office Action, the Examiner rejected claims 83, 93, 95, 96, and 99-102 under 35 U.S.C. § 112, ¶ 1 as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

According to the Examiner,

Applicant ... has not pointed to areas of the specification that show "said key generation system generates a **second** unique data identifier for the source file." Applicant has not shown support for a key generation system that generates two unique data identifiers for a single source file. Therefore all of other claim limitations that involve the second unique data identifier lack support. (emphasis original)

The Examiner, for example, asserts that the allegedly added material includes the data

management system, wherein "said key generation system generates a second unique data identifier for the source file, wherein said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier, and [wherein] said database system associates said second unique data identifier and the second source elements with the source file" as set forth in claim 93.

Other allegedly added material include the recitation of claim 95, wherein "said source print detection system compares the second source elements with corresponding target elements in the target file in accordance with said second unique data identifier and determines whether coincidence exists between the second course elements in the source file and the target elements in the target file." Claims 99-102 include similar recitations in method form, including a requirement that "said preselected coincidence level differs from said preselected coincidence level" as recited in claim 102.

Although Applicants respectfully disagree with the Examiner's allegation that claims 83, 93, 95, 96, and 99-102 were not fully supported by the specification, Applicants herein have added new claims 177-201. New claims 177-201 do not recite generation of a second unique data identifier for the source file, extraction of a second predetermined number of second source elements in accordance with said second unique data identifier, or any other recitations of allegedly added material as set forth above.

Accordingly, for at least the reasons set forth above, Applicants submit that all pending claims are fully supported by the original specification and respectfully request that the Examiner withdraw the claim rejections under 35 U.S.C. § 112, ¶ 1.

C. The Cited Prior Art References Do Not Disclose or Suggest Visually Comparing the Source File and the Target File to Determine a Level of Similarity Between the Source File and the Target File as Recited in Amended Claims 177-201.

In the Office Action, the Examiner also rejected claims 83-110 as being allegedly anticipated under 35 U.S.C. § 102(e) by Rabin et al., United States Patent No. 6,697,948, or rendered obviously under 35 U.S.C. § 103(a) by Rabin et al. alone or in combination with

Agrawal, United States Patent No. 5,647,058. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claims 177 and 187, Rabin et al. neither anticipates nor renders obvious independent claims 177 and 187. Therefore, it is submitted that independent claims 177 and 187, as well as claims 178-186 and 189-201 that depend thereon, are in condition for allowance.

Rabin et al. disclose an automated vendor tag system for software products, wherein the vendor tag system interacts with a monitoring program on a user device to inhibit unauthorized use. According to the Examiner, Rabin et al. at col. 21, lines 3-8 teach that "[a] verification program, resident on the guardian center, compares each fingerprint received from the user device against the fingerprints in its fingerprint data structure to determine if an untagged instance of software used on a user device is an infringing instance of software." See October 30, 2006, Office Action at page 7. The Examiner does not assert that Rabin et al. teach, in addition to an automated file comparison, performing a manual visual comparison to determine a level of similarity between the files as set forth in new independent claims 177 and 187.

At least one recited element of independent claims 177 and 187 therefore is totally missing from Rabin et al. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, Applicants submit that Rabin et al. fails to disclose each and every element of independent claims 177 and 187. Claims 177-201 therefore are not anticipated by Rabin et al. and are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of the Cited Prior Art References in a Manner that Precludes the Patentability of Claims 177-201 Under 35 U.S.C. § 103(a).

In addition to the reasons stated above, there is no teaching or motivation in the prior art to modify the teachings of Rabin et al. or Agrawal in a manner that renders claims 177-201 obvious under 35 U.S.C. § 103(a).

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met.” (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), *citing*, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

In the manner discussed in more detail above, at least one recited element of claims 177-201 is totally missing from Rabin et al. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Rabin et al. in a manner that renders claims 177-201 obvious. The Examiner does not rely on the teaching of Agrawal to supplement the disclosure of Rabin et al. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited prior art references. According, Applicants respectfully submit that claims 177-201 are not rendered obvious by Rabin et al., either alone or in combination with Agrawal, and therefore are in condition for allowance.

For at least the reasons set forth above, it is submitted that claims 177-201 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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